



DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 2 and 7

[Docket No. PTO-T-2021-0008]

RIN 0651-AD55

Changes to Implement Provisions of the Trademark Modernization Act of 2020;

Delay of Effective Date and Correction

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule and final rule; delay of effective date and correction.

SUMMARY: On November 17, 2021, the United States Patent and Trademark Office (USPTO or Office) published in the *Federal Register* a final rule amending its regulations to implement provisions of the Trademark Modernization Act of 2020 (TMA). This action changes the effective date for the regulations published in the November 17, 2021, final rule that established new Office action response periods and set fees for requests to extend Office action response deadlines. This action resets the effective date for responses and extensions from December 1, 2022, to December 3, 2022, in the examination of applications, and from December 1, 2022, to October 7, 2023, in the examination of post-registration filings.

DATES: *Delay of effective date:* As of [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER], in the final rule published at 86 FR 64300 on November 17, 2021, the effective date of amendatory instructions 3 (§ 2.6), 10 (§ 2.62), 11 (§ 2.63), 12 (§ 2.65), and 13 (§ 2.66) is delayed from December 1, 2022, to December 3, 2022, and the effective date of amendatory instructions 29 (§ 2.163), 30 (§ 2.165), 31 (§ 2.176), 33 (§ 2.184), 34 (§ 2.186), 37 (§ 7.6), 38 (§ 7.39), and 39 (§ 7.40) is delayed from December 1, 2022, to October 7, 2023.

Correction date: The correction to § 2.6 in this final rule is effective December 3, 2022.

Effective date: The amendment to § 2.6 in this final rule is effective October 7, 2023.

FOR FURTHER INFORMATION CONTACT: Catherine Cain, Office of the Deputy Commissioner for Trademark Examination Policy, USPTO, at 571-272-8946 or TMPolicy@uspto.gov.

SUPPLEMENTARY INFORMATION: On November 17, 2021, the USPTO published in the Federal Register a final rule amending the Rules of Practice in Trademark Cases to implement provisions of the TMA (86 FR 64300). As part of that final rule, the USPTO amended 37 CFR 2.62 to: (1) set a period of three months for responses to Office actions in applications under sections 1 and/or 44 of the Trademark Act (Act), and (2) provide the option to request a single three-month extension of the deadline, subject to the payment of a fee. The three-month response period and extension also applied to Office actions issued in connection with post-registration maintenance and renewal filings. The deadline for responses to Office actions issued in connection with applications under section 66(a) of the Act was not changed in that final rule and remains at six months. The final rule stated that the other changes would go into effect on December 1, 2022.

Under this final rule, the USPTO hereby resets the effective date for the regulations establishing Office action response periods and setting fees for requests to extend Office action response deadlines. The three-month response deadline and extension provisions for Office actions issued in connection with applications will be effective on December 3, 2022. The three-month response deadline and extension provisions for Office actions issued regarding post-registration maintenance filings will go into effect on October 7, 2023.

The change to the response deadline and the provision of an extension request involve significant updates to the USPTO's information technology (IT) systems and examination processes. The two-day change in the effective date to Saturday, December

3, 2022, for Office actions issued prior to registration will allow the USPTO to deploy the necessary IT updates without impacting applicants who have a response deadline of December 3, 2022, for Office actions issued prior to the effective date. When the deadline for a response to an Office action falls on a Saturday, Sunday, or Federal holiday, the response is considered timely if the action is received, or the fee is paid, on the following day that is not a Saturday, Sunday, or Federal holiday. 35 U.S.C. 21(b); 37 CFR 2.196. In the event of an unanticipated interruption in the Trademark Electronic Application System on December 3, 2022, parties who have a response due on that date would have until Monday, December 5, 2022, to submit a timely response.

Postponing the changes with regard to the deadline to respond to post-registration Office actions to October 7, 2023, will allow the USPTO additional time to update IT systems for the post-registration changes. This final rule will also provide the public an opportunity to more fully comprehend the nature of, and prepare to comply with, the new provisions before they are effective.

As a result of resetting the effective date, it was necessary to make corrections and amendments to the amendatory instruction and regulatory text at 37 CFR 2.6(a)(28), published in the November 17, 2021, final rule, to implement the new effective dates. No substantive changes were made to the provisions in § 2.6(a)(28).

Rulemaking Requirements

A. Administrative Procedure Act: The changes in this rulemaking involve rules of agency practice and procedure, and/or interpretive rules. See *Bachow Commc'ns Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals are procedural where they do not change the substantive standard for reviewing claims); and *Nat'l Org. of Veterans'*

Advocates v. Sec’y of Veterans Affairs, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive).

Accordingly, prior notice and opportunity for public comment for this rulemaking are not required pursuant to 5 U.S.C. 553(b) or (c), or any other law. See *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), do not require notice-and-comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice” (quoting 5 U.S.C. 553(b)(A))).

Moreover, the Director of the USPTO, pursuant to the authority at 5 U.S.C. 553(b)(B), finds good cause to adopt the change in this final rule without prior notice and an opportunity for public comment, as such procedures would be impracticable and contrary to the public interest. Immediate implementation of the resetting of the effective date, and the correction and amendment to the regulatory text, are in the public interest because they will allow the USPTO additional time to ensure that the means for the internal implementation of the provisions in the November 17, 2021, final rule are in place before it goes into effect. The additional time would also benefit the public, as it would provide an opportunity for the public to more fully comprehend the new response periods before they become effective. Delaying this final rule to satisfy notice-and-comment procedures is impracticable because doing so would allow the changes to the November 17, 2021, final rule that are being discussed in this final rule to go into effect before the USPTO is ready to implement the new response periods. Therefore, the Director finds there is good cause to waive notice-and-comment procedures for this final rule.

B. Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a Regulatory Flexibility

Act analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 et seq.) are required. *See* 5 U.S.C. 603.

C. Executive Order 12866 (Regulatory Planning and Review): This rule has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. Executive Order 13563 (Improving Regulation and Regulatory Review): The USPTO has complied with Executive Order 13563 (Jan. 18, 2011). Specifically, the USPTO has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) provided the public with a meaningful opportunity to participate in the regulatory process, including soliciting the views of those likely affected, prior to issuing a notice of proposed rulemaking, and provided online access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across Government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes, to the extent applicable.

E. Executive Order 13132 (Federalism): This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

F. Executive Order 13175 (Tribal Consultation): This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes, (2) impose substantial direct compliance costs on Indian tribal governments, or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

G. Executive Order 13211 (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 because it is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

H. Executive Order 12988 (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and (b)(2) of Executive Order 12988 (Feb. 5, 1996).

I. Executive Order 13045 (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

J. Executive Order 12630 (Taking of Private Property): This rulemaking will not affect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

K. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), the USPTO will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this rule are not expected to result in an annual effect on the economy of \$100 million or more; a major increase in costs or prices; or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this rule is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

L. Unfunded Mandates Reform Act of 1995: The changes set forth in this rulemaking do not involve a Federal intergovernmental mandate that will result in the expenditure by

State, local, and tribal governments, in the aggregate, of \$100 million (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of \$100 million (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

M. National Environmental Policy Act of 1969: This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

N. National Technology Transfer and Advancement Act of 1995: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions that involve the use of technical standards.

O. Paperwork Reduction Act of 1995: This final rule does not involve information collection requirements that are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.).

Notwithstanding any other provision of law, no person is required to respond to, nor shall any person be subject to, a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information has a valid OMB control number.

P. E-Government Act Compliance: The USPTO is committed to compliance with the E-Government Act to promote the use of the internet and other information technologies to provide increased opportunities for citizen access to Government information and services, and for other purposes. For information pertinent to E-Government Act compliance related to this rule, please contact Justin Isaac, Acting USPTO Information Collection Officer, at Information.Collection@uspto.gov or 571-272-7392.

List of Subjects in 37 CFR Part 2

Administrative practice and procedure, Courts, Lawyers, Trademarks.

Correction to November 2021 Final Rule

Effective December 3, 2022, in FR Doc. 2021-24926, at 86 FR 64300 in the *Federal Register* of Wednesday, November 17, 2021, on page 64325, in the second column, in amendatory instruction 3 for § 2.6, paragraph (a)(28) is corrected to read as follows:

§ 2.6 [Corrected]

(a) * * *

(28) *Extension of time for filing a response to an Office action under § 2.62(a)(2).* (i) For filing a request for an extension of time for filing a response to an Office action under § 2.62(a)(2) on paper—\$225.00.

(ii) For filing a request for an extension of time for filing a response to an Office action under § 2.62(a)(2) via TEAS—\$125.00.

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For the reasons stated in the preamble and under the authority contained in 15 U.S.C. 1123 and 35 U.S.C. 2, as amended, the USPTO amends part 2 of title 37 as follows:

PART 2 - RULES OF PRACTICE IN TRADEMARK CASES

1. The authority citation for part 2 continues to read as follows:

Authority: 15 U.S.C. 1113, 1123; 35 U.S.C. 2; sec. 10, Pub. L. 112-29, 125 Stat. 284; Pub. L. 116-260, 134 Stat. 1182, unless otherwise noted. Sec. 2.99 also issued under secs. 16, 17, 60 Stat. 434; 15 U.S.C. 1066, 1067.

2. Effective October 7, 2023, amend § 2.6 by revising paragraph (a)(28) to read as follows:

§ 2.6 Trademark fees.

(a) * * *

(28) *Extension of time for filing a response to an Office action under § 2.62(a)(2), § 2.163(c), § 2.165(c), § 2.176, § 2.184(b)(2), or § 2.186(c).* (i) For filing a request for an extension of time for filing a response to an Office action under § 2.62(a)(2), § 2.163(c), § 2.165(c), § 2.176, § 2.184(b)(2), or § 2.186(c) on paper—\$225.00.

(ii) For filing a request for an extension of time for filing a response to an Office action under § 2.62(a)(2), § 2.163(c), § 2.165(c), § 2.176, § 2.184(b)(2), or § 2.186(c) via TEAS—\$125.00.

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Katherine K. Vidal,

*Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office.*

[FR Doc. 2022-22217 Filed: 10/12/2022 8:45 am; Publication Date: 10/13/2022]